

REMARKS

Amendments to the Claims

Claim 17 has been amended by addition of the word “is” in order to correct the grammar of that claim. Claim 18 has been amended by replacing the term “methoxy” with the term “methoxide” such that the claim now properly recites the name of the base “sodium methoxide.” Applicant respectfully submits that no new matter has been added by this amendment.

Objection to the Specification

The Examiner has objected to the specification due to the alleged informality in reciting that the instant application is a divisional application of Application No. 09/850,545 filed on May 7, 2001, which became U.S. Patent No. 6,828,134 (hereinafter referred to as the ‘134 patent). The Examiner asserts that the specification should be amended to recite that the instant application is a continuation of Application No. 09/850,545. Applicants respectfully traverse the objection to the specification.

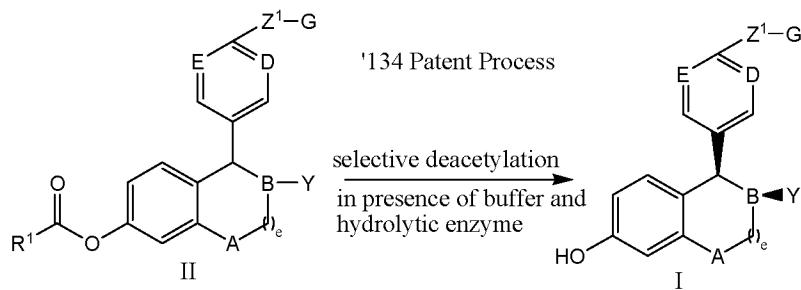
Applicant respectfully submits that the instant application is a proper divisional application of Application No. 09/850,545 (hereinafter referred to as the ‘545 application), now the ‘134 patent. During the prosecution of the parent ‘545 application, applicants were required to make an election/restriction under 35 U.S.C. §121 from one of four independent and distinct inventions as determined by the Examiner in the Office Action dated October 2, 2002 (attached hereto as Exhibit A). The independent and distinct inventions were restricted as follows: Group I, claims 1-14; Group II, claims 15-23; Group III, claims 24-33 and Group IV, claims 34-40 (see pages 3-4 of Exhibit A).

Applicant elected to prosecute Group I, claims 1-14 in the response filed November 1, 2002 (attached hereto as Exhibit B). Prosecution on the merits of the Group I claims resulted in allowance of those claims following an Examiner’s amendment that was authorized during a telephonic interview conducted between the Examiner and Applicant’s representative on December 3, 2003. In the statement regarding the Examiner’s amendment (attached hereto as Exhibit C) it was noted that “Claims 15-40 have been canceled. Applicant reserves the right to file one or more divisional applications regarding the subject matter of the canceled claims.” Applicant subsequently filed the instant application as a divisional of the allowed ‘545 application on March 2, 2004. Thus, the instant application is a proper divisional application in accord with both the requirements of 35 U.S.C. §121 and the Examiner’s admission that Applicant reserved the right to file one or more divisional applications directed to the subject matter of the canceled claims. For these reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the objection to the specification.

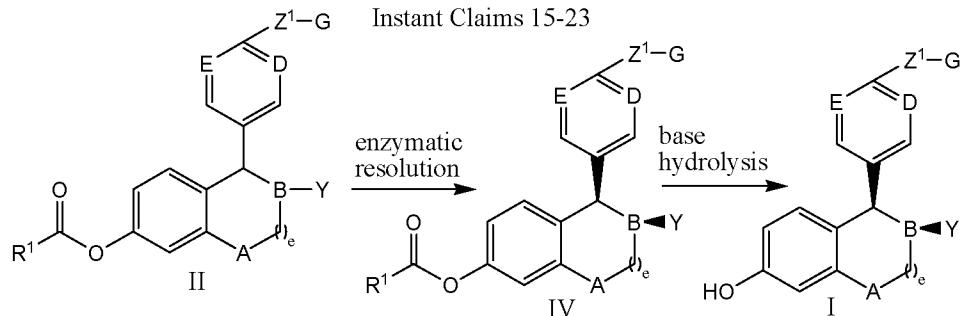
The non-statutory obviousness type double patenting rejection

Claims 15-23 have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-14 of the ‘134 patent. The Examiner has alleged that the instant claims are not patentably distinct from claims 1-14 of the ‘134 patent and has further alleged that the instant claims encompass the claimed invention of the ‘134 patent. Applicant respectfully traverses this non-statutory obviousness-type double patenting rejection.

Applicant respectfully submits that the instant application is a proper divisional application of the parent ‘545 application, now the ‘134 patent, as described hereinabove in the objection to the specification section. Further, Applicant respectfully submits that the instant claims do not encompass the subject matter of claims 1-14 of the ‘134 patent. Claims 1-14 of the ‘134 patent pertain to a process of preparing a compound of formula I by selectively deacetylating the acetylated compound of formula II in the presence of an aqueous buffer solution and a hydrolytic enzyme such as a lipase, esterase or liver acetone powder, as depicted below.



Instant claims 15-23 pertain to a process of preparing a compound of I by first resolving the acetylated compound of formula II to the resolved acetylated compound of formula IV followed by base hydrolysis to provide the compound of Formula I, as depicted below.



Instant claims 15-23 are directed to a different process than the process of claims 1-14 of the '134 patent. Although both processes are useful for preparing a compound of Formula I, the processes differ and instant claims 15-23 do not encompass the process of claims 1-14 of the '134 patent. Since the instant claims are patentably distinct from claims 1-14 of the '134 patent and the present application is a division of the '545 application from which the '134 patent issued Applicant respectfully submits that the instant claims should not be rejected under the judicially created doctrine of obviousness-type double patenting. For these reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the obviousness-type double patenting rejection of instant claims 15-23.

Applicants, having addressed all points and concerns raised by the Examiner, believe that the application is in condition for allowance.

Respectfully submitted,

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